



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,053	09/01/2000	Takashi Sasaki	0754-0155P	5947
2292	7590	07/11/2003		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER	
			CRENSHAW, MARVIN P	
		ART UNIT	PAPER NUMBER	
		2854		

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/654,053	SASAKI, TAKASHI
	Examiner	Art Unit
	Marvin P. Crenshaw	2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on the election filed 4/05/2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-4,6,7,12,13 and 16-19 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 5,11,14 and 15 is/are rejected.
- 7) Claim(s) 8-10 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 September 2000 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____ .
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 12,13 and 16-18 are directed to an invention that is independent or distinct from the elected invention.

These method claims are dependent from non-elected claims and are distinct from the elected invention for the reasons set forth in paper #4.

Accordingly, claims 12,13 and 16-18 are withdrawn from consideration as being directed to a non-elected invention.

Allowable Subject Matter

Claims 8 - 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance:

With respect to claim 8, the prior art does not teach or render obvious the total combination as claimed including a golf ball having a basic resin further containing a polymer which is substantially free of hydroxyl groups.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5, 11,14 and 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirukawa et al. (JP11139095) in view of Yang.

Hirukawa et al. (JP11139095) teaches a pattern directly printed on a surface of the golf ball body (See page 1, paragraph 0001) with use of a transfer foil, the pattern being defined by an ink comprising a basic resin (See paragraph 007) containing a polyurethane having a hydroxyl value (See page 1, paragraph 0008) of less than 0.2 and a coloring agent (the ink) and a clear coat (see page 2, paragraph 0024) formed over the pattern and the ball body surface. Hirukawa et al. doesn't teach a polyurethane having the claimed molecular weight.

Yang teaches having a hydroxyl value having a weight-average molecular weight of 20,000 to 60,000 (See col. 4, lines 10 – 15).

It would be obvious to modify Hirukawa et al. to have a polyurethane having the claimed molecular weight as taught by Yang because the ink composition is at it's best for wear and durability when at that range.

With respect to claim 11, Hirukawa et al. doesn't teach a golf ball wherein the basic resin consists essentially of the polyurethane.Yang teaches a golf ball wherein the basic resin consists essentially of the polyurethane (Col. 3, lines 65 - 67).

It would be obvious to modify Hirukawa et al. to have a golf ball wherein the basic resin consists essentially of the polyurethane as taught by Yang because it is a good binding agent for the ink composition.

Response to Arguments

With respect to applicant's argument about the restriction requirement, the restriction requirement was previously made final and that applicant's arguments were addressed in the previous office action.

Applicant's arguments with respect to claim 5 have been considered but are moot in view of the new ground(s) of rejection. Specifically, Hirukawa et al. teaches all that is claimed of having a transfer foil for printing a pattern using an ink on a golf ball.

Yang has been added to teach the range of the polyurethane having an average molecular weight. With the respect to the applicant's argument about "routine experimentation", that with testing printed ink on golf balls which composition of the molecular weight of the ink on the golf ball would be the most effective when the ball is in use for durability and wear.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marvin P. Crenshaw whose telephone number is (703) 308-0797. The examiner can normally be reached on Monday - Friday 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

Application/Control Number: 09/654,053
Art Unit: 2854

Page 5

308-7722 for regular communications and (703) 308-7724 for After Final
communications.

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the receptionist whose telephone number is (703) 308-
0956.

WCL

MPC
June 30, 2003

AH

ANDREW H. HIRSHFELD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800